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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,680	04/05/2001	Michael G. Coutts	8717.00	3504
26889	7590	08/05/2009	EXAMINER	
MICHAEL CHAN			LASTRA, DANIEL	
NCR CORPORATION			ART UNIT	PAPER NUMBER
1700 SOUTH PATTERSON BLVD			3688	
DAYTON, OH 45479-0001				
MAIL DATE		DELIVERY MODE		
08/05/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL G. COUTTS and LEE G. DOVE

Appeal 2009-000374
Application 09/826,680
Technology Center 3600

Decided: August 5, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

1 STATEMENT OF THE CASE
2

3 Michael G. Coutts and Lee G. Dove (Appellants) seek review under 35
4 U.S.C. § 134 of a final rejection of claims 16-32, the only claims pending in
5 the application on appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8
9 We AFFIRM-IN-PART.

10 The Appellants invented an ATM for displaying authorized
11 advertisements during a transaction. Specification 1:5-6.

12 An understanding of the invention can be derived from a reading of
13 exemplary claim 16, which is reproduced below [bracketed matter and some
14 paragraphing added].

15 16. An automated teller machine (ATM) for dispensing cash in
16 the form of paper money to an ATM customer conducting a
17 cash dispense transaction at the ATM and for displaying
18 advertisements for the ATM customer to view while the ATM
19 customer is conducting the cash dispense transaction at the
20 ATM, the ATM comprising:

21 [1] a cash dispenser
22 for dispensing cash to an ATM customer
23 when the customer is conducting a cash dispense
24 transaction at the ATM;
25 [2] an ATM display;
26 [3] means for accessing an advertisement database

1 to retrieve an authorized advertisement associated with
2 the ATM; and

3 [4] means for incorporating the retrieved advertisement in a
4 screen

5 for displaying on the ATM display

6 to allow the ATM customer to view the screen

7 while the ATM customer is conducting the cash dispense
8 transaction at the ATM.

9
10 This appeal arises from the Examiner's Final Rejection, mailed July 13,
11 2006. The Appellants filed an Appeal Brief in support of the appeal on
12 April 23, 2007. An Examiner's Answer to the Appeal Brief was mailed on
13 April 11, 2008. A Reply Brief was filed on June 16, 2008.

PRIOR ART

15 The Examiner relies upon the following prior art:

Drummond¹ US 60/149,765 Aug. 19, 1999

Gupta US 6,487,538 B1 Nov. 26, 2002

Drummond US 2005/0216888 A1 Sep. 29, 2005

REJECTIONS

17 Claims 16-24, 26-28, and 30-32 stand rejected under 35 U.S.C. § 102(b)
18 as anticipated by Drummond.

19 Claims 25 and 29 stand rejected under 35 U.S.C. § 103(a) as
20 unpatentable over Drummond and Gupta.

¹ This is the provisional application upon which the published application relies for the benefit of priority. It is unpublished but is publicly accessible. See discussion *infra*.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 16-24, 26-28, and 30-32 under 35 U.S.C. § 102(b) as anticipated by Drummond.
 - This issue turns on whether Drummond is entitled to the filing date of its provisional application, and whether Drummond describes various limitations in the claims.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 25 and 29 under 35 U.S.C. § 103(a) as unpatentable over Drummond and Gupta.

This issue turns on whether Drummond and Gupta describe various limitations and whether one of ordinary skill would have applied the references together.

FACTS PERTINENT TO THE ISSUES

16 The following enumerated Findings of Fact (FF) are believed to be
17 supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “allocation time.”

Facts Related to Appellants' Disclosure

02. The Specification discloses that, "allocation times may[, for example,] include: 'dead time' during a transaction; a period

1 prior to a user entering his/her card; or such like". Specification
2 3:24-26.

3 03. One implementation of advertisement screening is for
4 advertisements to be screened after being added to a database and
5 accessed after being screened. Specification 5:24-25.

6 *Drummond*

7 04. Drummond is directed to a banking machine connected to a
8 computer, a sheet dispenser mechanism, card reader and other
9 physical transaction function devices in the banking machine. The
10 computer includes software for handling HTML or other
11 documents to send and receive HTML documents and HTTP
12 messages. Drummond ¶ 0030. Provisional Application 7:1-18.

13 05. Drummond describes software used in the computer, which
14 includes a browser operative to process documents and cause a
15 computer to produce outputs. Drummond ¶ 0074. Provisional
16 Application 16:9-15.

17 06. Drummond describes using the document(s) or record(s) which
18 contain the customer data to dynamically generate a document for
19 the particular customer in the particular circumstances to reduce
20 the effort associated with developing in advance a personal visual
21 page or document for each customer. This may involve including
22 various types or categories of user information in the document(s)
23 or record(s) that pertain to a particular customer, such as gender,
24 related persons, account types, permitted transactions, customer
25 preferences, customer interests, account balances, previous offers

1 declined or accepted and other information. This customer
2 information can be used to generate an appropriate document for
3 the browser to access based on the customer "profile" and the
4 transaction devices present in the particular machine, information
5 on which is stored in a data store in the machine or elsewhere in
6 the system, as well as other factors such as the day of the week
7 and time of day based on a system clock. Drummond ¶ 0113-14.
8 Provisional Application 32:1-16.

9 07. The profile applet builds and accesses transaction documents
10 and may offer incentives, premiums, additional transaction
11 options or advertising information selectively to customers.
12 Drummond ¶ 0115. Provisional Application 32:17 – 33:3.

13 08. Drummond describes causing the ATM computer to access
14 other documents in other servers, such as stock market data, and
15 selectively provide it to customers. The profile applet may
16 generate documents to produce initial display screens of a
17 transaction sequence and may also operate to provide information
18 or access or produce documents which generate visual outputs to
19 the customer at other points in a transaction or between
20 transactions. This may further be used in systems in which the
21 operator of the machine is able to sell paid advertising to third
22 parties and then access the HTTP records such as HTML files
23 corresponding to those third parties' products or services. Such
24 accessing may be done based on a periodic or other basis, but may
25 be done effectively by selecting the HTTP record to access in
26 response to the profile of the particular customer. As later

1 described, advertising documents may be accessed from
2 advertising servers connected to the network. Advertising
3 materials may be delivered to customers from the machine at
4 various times during transactions, such as between steps
5 controlled by documents from the server operated by the
6 customer's institution. Advertising materials may be displayed
7 when transaction function devices, such as a sheet dispenser are
8 operated. The operator of the machine and/or a system in which
9 the machine is connected, may also require payment from
10 advertisers for presenting the advertising materials. Drummond ¶
11 0116. Provisional Application 33:4-20.

12 09. Drummond describes using HTML documents to process an
13 ATM transaction between the browser and the home server. The
14 document returned from the home server may include advertising
15 or other information instead of or in addition to the customer
16 message. The document returned may also include an instruction
17 which causes the machine to access or generate another document.
18 These instructions may invoke methods in the profile applet which
19 depend on the properties associated with the customer, the
20 machine, the current time and/or other circumstances. This
21 enables accessing documents that provide promotional messages
22 such as advertising or other information to the customer while the
23 customer is waiting for the sheet dispenser or other transaction
24 function device in the machine to operate. Drummond ¶ 0121.
25 Provisional Application 35:5-12.

1 10. The home HTTP server may deliver documents selectively to
2 the ATMs. Examples of particularly tailored screens may include
3 bilingual messages in certain neighborhoods or information
4 concerning currency exchange at various ports of entry. The
5 material or messages could include advertising for various
6 products or services or other material targeted to particular
7 machine locations. The JAVA applets and JAVA script are loaded
8 from a central location providing selective software distribution in
9 the ATMs which may also be used to tailor the ATM to its
10 environment by causing it to access documents which include
11 material intended to be useful in that location, and which is not
12 provided in documents delivered to at least some other machines
13 in the system. Drummond ¶ 0088. Provisional Application 21:13-
14 23.

15 11. These documents may be accessed from servers connected to
16 the Internet. This enables operators of ATMs and other transaction
17 machines to present advertising to customers, on a broad basis, or
18 targeted to categories of customers or even targeted to individual
19 customers on a segment of one basis.

20 “This could be advertising of the machine operator such as
21 a bank, or advertising pertaining to virtually any type of
22 goods or services. The advertising may also be selectively
23 presented based on the particular transaction device being
24 operated, the amount of funds involved or other
25 parameters. Access to advertising documents may be
26 tracked and payments made to the customer's institution,

the operator of the system and/or the owner of the machine, by the entity associated with the advertising materials presented to the customers.”

Drummond ¶ 0121. Provisional Application 35:12 – 36:2.

12. Drummond describes how the data and applets used may be used for a lab exercise. DRAFT 1/12/2017

Provisional Application 38:17-20.

13. Drummond describes use of a device server to monitor transactions for security. Drummond ¶ 0034. Provisional Application 8:11-18

14. The Examiner has shown that all of the passages relied on in Drummond are fully described with essential duplication in the provisional application 60/149,765 (Ans. 10) and that there was a proper chain of applications for the benefit. Answer 8-9.

Facts Related To The Level Of Skill In The Art

15. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, on line advertising systems, advertising and promotion design, and database system design. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for

1 testimony is not shown'') (quoting *Litton Indus. Prods., Inc. v.*
2 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

3 *Facts Related To Secondary Considerations*

4 16. There is no evidence on record of secondary considerations of
5 non-obviousness for our consideration.

6

7 PRINCIPLES OF LAW

8 *Claim Construction*

9 During examination of a patent application, pending claims are
10 given their broadest reasonable construction consistent with the
11 specification. *In re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969);
12 *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369. (Fed. Cir.
13 2004).

14 Limitations appearing in the specification but not recited in the claim are
15 not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,
16 1369 (Fed. Cir. 2003) (claims must be interpreted "in view of the
17 specification" without importing limitations from the specification into the
18 claims unnecessarily). *See also Tex. Digital*, 308 F.3d 1200, 1204-05.

19 Although a patent applicant is entitled to be his or her own lexicographer
20 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*
21 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing
22 such definitions in the specification with sufficient clarity to provide a
23 person of ordinary skill in the art with clear and precise notice of the
24 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480
25 (Fed. Cir. 1994) (although an inventor is free to define the specific terms

1 used to describe the invention, this must be done with reasonable clarity,
2 deliberateness, and precision; where an inventor chooses to give terms
3 uncommon meanings, the inventor must set out any uncommon definition in
4 some manner within the patent disclosure so as to give one of ordinary skill
5 in the art notice of the change).

6 *Anticipation*

7 "A claim is anticipated only if each and every element as set forth in the
8 claim is found, either expressly or inherently described, in a single prior art
9 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
10 631 (Fed. Cir. 1987). "When a claim covers several structures or
11 compositions, either generically or as alternatives, the claim is deemed
12 anticipated if any of the structures or compositions within the scope of the
13 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
14 Cir. 2001). "The identical invention must be shown in as complete detail as
15 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
16 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
17 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
18 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

19 *Obviousness*

20 A claimed invention is unpatentable if the differences between it and
21 the prior art are "such that the subject matter as a whole would have been
22 obvious at the time the invention was made to a person having ordinary skill
23 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550
24 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13. (1966).

25 In *Graham*, the Court held that that the obviousness analysis is
26 bottomed on several basic factual inquiries: "[1] the scope and content of

1 the prior art are to be determined; [(2)] differences between the prior art and
2 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
3 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 550 U.S. at
4 406. “The combination of familiar elements according to known methods is
5 likely to be obvious when it does no more than yield predictable results.” *Id.*
6 at 416.

7 ANALYSIS

8 *Claims 16-24, 26-28, and 30-32 rejected under 35 U.S.C. § 102(b) as
9 anticipated by Drummond.*

10 *Claims 16, 17, 19, 28, 31, and 32*

11 The Appellants argue independent claim 16 and presents no separate
12 arguments for independent claims 19 and 28, and dependent claims 17, 31,
13 and 32. Accordingly, we treat these claims as a group, and we select claim
14 16 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

15 The Appellants contend that the Examiner has not shown that
16 Drummond is prior art, by showing that it met the requirements for the
17 benefit of the provisional application filing date. Appeal Brief 20-21. The
18 Examiner has provided this showing in the Answer. FF 14.

19 The Appellants spend a great deal of their Appeal and Reply Briefs
20 contending they have been unable to obtain a copy of the provisional
21 application. We have verified that a copy of the provisional application is
22 available to the public on Public PAIR on the U.S. Patent & Trademark
23 Office’s web site.²

24

² <http://portal.uspto.gov/external/portal/pair>

1

2 *Claim 18*

3 Claim 18 contains the limitation that the ATM program is operable to
4 allocate screen space to the Web browser in accordance with predefined
5 allocation times. The Appellants contend that Drummond fails to describe
6 the browser and use allocation times. Appeal Brief 21-22. We disagree.
7 Drummond describes a browser used in the ATM's computer. FF 05.
8 Drummond also describes using its applet to generate documents such as
9 advertising on the browser between steps with a transaction, between
10 transactions or when physical paper sheets are being dispensed (FF 08) or
11 while the customer is waiting for some device to complete its operation. (FF
12 09). The Specification does not define "allocation time" (FF 01), but does
13 disclose that examples include transaction dead time (FF 02). Dead time is,
14 generally, time that a customer is waiting. So, time between transactions
15 and time waiting for a device to operate which Drummond uses for
16 displaying advertisements on a browser would be examples of allocating
17 screen space to the Web browser in accordance with predefined allocation
18 times.

19 *Claim 20*

20 As with claim 16, the Appellants contend that the Examiner has not
21 shown that Drummond is prior art by showing that it met the requirements
22 for the benefit of the provisional application filing date. Appeal Brief 22-23.
23 The Examiner has provided this showing in the Answer. FF 14.

24 *Claim 21*

25 Claim 21 requires logging the number of times the advertisement
26 database has been accessed by each ATM and applying a charge to each

1 advertisement based on the number of accesses. The Appellants contend
2 that Drummond fails to describe an advertising database or applying a
3 charge to each advertisement based on the number of accesses. Appeal Brief
4 23-24.

5 We disagree. Drummond explicitly describes the use of a database
6 server to store all the data, including advertising data, in a database. FF 12.
7 Drummond also describes tracking access to advertisements and paying the
8 party presenting the advertisement, accordingly. FF 11. The Appellants
9 contend this passage only refers to payment. However the sentence in which
10 payment is described begins with tracking access to the advertising
11 documents.

12 Access to advertising documents may be tracked and payments made to
13 the customer's institution, the operator of the system and/or the owner of the
14 machine, by the entity associated with the advertising materials presented to
15 the customers.

16 Drummond ¶ 0121. The structure of the sentence clearly demonstrates
17 the nexus between accesses to the advertisements tracked and payment,
18 particularly in light of the notoriety of advertising revenue based on number
19 of views. Drummond ¶ 0121.

20 *Claims 22-24*

21 Claim 22 is independent and requires, "a server interconnected to the
22 ATM and for accessing the advertisement database in response to a request
23 from the ATM." Appeal Brief 24. The Appellants present no separate
24 arguments for dependent claims 23 and 24. *See* Appeal Brief. The
25 Appellants contend that Drummond does not describe such a server. Appeal
26 Brief 24-25. As we found with claim 21, *supra*, Drummond does describe
27 such a server. FF 12.

1

2 *Claim 26*

3 Claim 26 is independent and requires two servers, one to authorize cash
4 transactions and one to retrieve advertisements. The Appellants contend that
5 Drummond fails to describe both servers. Appeal Brief 25.

6 We disagree. As found *supra*, Drummond shows a database server for
7 advertisements. FF 12. Drummond also shows use of a device server for
8 transaction security, which would include cash transactions. FF 13.

9 *Claim 27*

10 Claim 27 is independent and requires screening an advertisement,
11 transmitted from an ATM, and storing it after screening. The Appellants
12 contend that Drummond fails to describe this. We agree with the
13 Appellants.

14 The Examiner found that Drummond described this at ¶'s 0088, 0142,
15 and 0151. Answer 14-15. ¶'s 0142 and 0151 describe generic security
16 screening software, such as for a firewall or for avoiding sending data to an
17 inappropriate address and have nothing to do with screening the
18 advertisements. ¶ 0088 does describe screening the advertisements, but in
19 the opposite direction from that claimed. Drummond screens advertisements
20 in the database before sending them to an ATM, rather than screening
21 advertisements from the ATM to a database as claimed. FF 10.

22 *Claim 30*

23 Claim 30 is independent and requires a means for screening
24 advertisements. The Appellants contend that this means is not described by
25 Drummond. Appeal Brief 27.

1 We disagree with the Appellants. As we found *supra* under claim 27,
2 Drummond screens advertisements in the database before sending them to
3 an ATM. Unlike claim 27, claim 30 simply requires a means for screening.
4 One disclosed implementation of advertisement screening is for
5 advertisements to be screened after being added to a database and accessed
6 after being screened. FF 03.

7 The Appellants also argue whether means, for applying display criteria
8 to advertisements and transmitting advertisements to ATM's, are described.
9 But because Drummond applies the screening at the time of the customer
10 presence, such viewing of screened data would necessitate applying display
11 criteria and transmission to the ATM. FF 10.

12

15 Both claims 25 and 29 recite a limitation of screening an advertisement
16 to determine whether it meets an acceptance criterion. Claim 29 screens
17 advertisements in a manner similar to the limitation in claim 27.
18 Accordingly, we do not sustain the rejection for the same reasons. Claim 25
19 is dependent from claim 22 and, like claim 30, does not specify the timing of
20 the screening. The Appellants argue that one cannot combine Gupta with
21 Drummond because doing so would change Drummond's operation or
22 render it inoperable. Appeal Brief 27-39. Most of the Appellants'
23 arguments are pertinent to claim 29, whose rejection we will not sustain for
24 the aforementioned reasons. The sole purpose the Examiner relied on Gupta
25 for with respect to claim 25 is an elaboration of the screening methodology.
26 Answer 6. Thus, the rejection of claim 25 does not rely on the portions of

1 Gupta that the Appellants argue would render Drummond inoperable or
2 unfit. We will sustain the rejection of claim 25.

3 CONCLUSIONS OF LAW

4 The Appellants have not sustained their burden of showing that the
5 Examiner erred in rejecting claims 16-24, 26, 28, and 30-32 under 35 U.S.C.
6 § 102(b) as anticipated by Drummond.

7 The Appellants have sustained their burden of showing that the
8 Examiner erred in rejecting claim 27 under 35 U.S.C. § 102(b) as anticipated
9 by Drummond.

10 The Appellants have sustained their burden of showing that the
11 Examiner erred in rejecting claim 29 under 35 U.S.C. § 103(a) as
12 unpatentable over the Drummond and Gupta.

13 The Appellants have not sustained their burden of showing that the
14 Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) as
15 unpatentable over the Drummond and Gupta.

16 DECISION

17 To summarize, our decision is as follows:

- 18 • The rejection of claims 16-24, 26, 28, and 30-32 under 35 U.S.C. §
19 102(b) as anticipated by Drummond is sustained.
- 20 • The rejection of claim 27 under 35 U.S.C. § 102(b) as anticipated by
21 Drummond is not sustained.
- 22 • The rejection of claim 29 under 35 U.S.C. § 103(a) as unpatentable
23 over Drummond and Gupta is not sustained.

1 • The rejection of claim 25 under 35 U.S.C. § 103(a) as unpatentable
2 over Drummond and Gupta is sustained.

3 No time period for taking any subsequent action in connection with this

4 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

8 /mev

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